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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,196	03/18/2004	Yoshiyuki Baba	81756.0007	5112
26021 7590 10/31/2007 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/803,196	BABA, YOSHIYUKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHAN S. PARK	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**DOUGLAS Q. TRAN**  
**PRIMARY EXAMINER**

*Translour*      *Chan S. Park*

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 6 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP

2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claim 6, while defining a computer program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium storing an option computer program..." in order to make the claim statutory.

***Claim Objections***

2. Claims are objected to because of the following informalities:

Claims 1, 5 and 6, "(below, referred to as "the connected printer")" should be deleted since the claim wording is evidently clear that the printer is "the connected printer".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to claim 1, it recites the limitations for inquiring "a print function usable with the connected printer" and realizing "a specific function". It is unclear as to how those two functions are different. According to page 6, lines 19-26 of the Specification, the difference is not clear. For example, if the inquired color print function is designated and operated to realize the specific function, what function should be construed as the "specific function"? How is the step of inquiring different from the step of realizing? Explanation/clarification from the Specification is respectfully requested.

4. Furthermore, it recites the limitation "a print function usable with the connected printer". It is unclear if there ever is a situation where the print function is not usable with the connected printer. With respect to what, is the print function determined to be usable or not usable? Or is it simply claiming the printer capability regardless the presence/absence of the option module? Explanation/clarification from the Specification is respectfully requested.
5. With respect to claims 5 and 6, arguments analogous to those presented for claim 1, are applicable.
6. Claim 7 recites the limitation "a printer". There is insufficient antecedent basis for this limitation in the claim. It is unclear if it is referring to the same printer recited in claim 1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Breidenbach et al. U.S. Patent Application Publication No. 2003/0084085 (hereinafter Breidenbach).

7. With respect to claim 1, Breidenbach discloses an option module (peripheral device software 210 in fig. 2 or auto recognition logic 410, 420, 430 in fig. 4) for realizing a specific function (printing the data in specific function supported by the printer capabilities) while being connected to a printer (fig. 3), comprising:

means for inquiring to the printer to which the option module is connected regarding a print function (step 312 or paragraphs 49~53) usable with the connected printer (fig. 5 & paragraphs 40~42 & 53~55),

wherein only the print function usable with the connected printer is designated and operated to realize the specific function (paragraphs 40~42 & 53~55).

8. With respect to claim 2, Breidenbach discloses the option module according to claim 1, wherein the specific function (printing the data in specific function supported by the printer capabilities) is a function for generating a print image based on data described in a printer control language. Note that generating the print image data based on data described in a printer control language is inherent since the printer must be able to understand the control command to perform the printing task.

9. With respect to claim 3, Breidenbach discloses the option module according to claim 1, wherein the print function includes at least one of: a function to print at a specific resolution level, a double-sided print function, a print function using a secondary memory device, a print function using a specific paper feeder or paper discharge tray, a

print function using a mailbox, a collate print function, and a color print function (paragraphs 52~55).

10. With respect to claim 4, Breidenback discloses the option module according to claim 1, wherein the option module is a memory device storing a program, and the program is executed on the printer to realize the specific function (paragraph 31).

11. With respect to claims 5 and 6, arguments analogous to those presented for claim 1, are applicable.

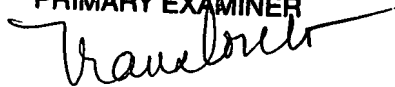
12. With respect to claim 7, Breidenback discloses a printing system, comprising: the option module according to claim 1; and a printer constructed so as to be able to connect with the option module (fig. 4).

**Contact Information**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DOUGLAS Q. TRAN  
PRIMARY EXAMINER  


Chan S. Park  
Examiner  
Art Unit 2625



csp  
October 24, 2007